

REMARKS

Claims 1-34 are currently pending in the application. Applicants request reconsideration of the rejections set forth in the Office Action against the pending claims on the basis of at least the following remarks.

Rejections under 35 U.S.C. §102(e)

In the Office Action, Claims 1-34 stand rejected under 35 U.S.C. §102(e) in view of a United States patent issued to Reddy (U.S. Pat. No. 6,564,191).

Claim 1 of the present application recites (with emphasis added):

An investment management system in communication with at least one of a data vendor and an accounting system, comprising: an application server, the application server having logic configured to perform at least the following: portfolio analysis of an investment portfolio, wherein the portfolio analysis includes aggregating a plurality of securities in the investment portfolio by security type; portfolio monitoring of the investment portfolio; reporting at least one holding of the investment portfolio; and a database server in communication with the application server.

The Office Action states that “Because the claim language stated ‘at least one’ (=>) only one item needs to be referenced in the prior art to deny the claim.” (see Office Action, p. 3). However, as is clear from the language of current Claim 1, the “application server” has “logic configured to perform at least” the functions listed in Claim 1, namely, “portfolio analysis of an investment portfolio, wherein the portfolio analysis includes aggregating a plurality of securities in the investment portfolio by security type”, “portfolio monitoring of the investment

portfolio” and “reporting at least one holding of the investment portfolio” which means at least all of these functions are included.

However, applicants respectfully submit that Reddy cannot be applied as prior art against the pending claims under §102(e) in view of actual reduction to practice of the claimed invention by the applicants prior to February 24, 2000, which appears to be the earliest claimed priority date of Reddy.

Applicants submit herewith a “Declaration to Antedate Cited Reference” (see Attachment I) executed by all inventors (including Robert S. Stewart and Roland E. Collins III) that states, in pertinent part at paragraph 3:

We conceived and reduced to practice the invention described and claimed in the Subject Application (“Invention”) prior to February 24, 2000, including embodiments of an integrated investment management system (“IIMS”) and associated methods having the following features and functions: the IIMS included an application server in communication with a database server; the IIMS could perform analysis of investment portfolios by aggregating a plurality of securities in the investment portfolio by security type; the IIMS could monitor investment portfolios and generate reports associated with holdings of the investment portfolios; and the IIMS could perform operations using data from accounting systems and/or data vendors.

As can be seen from the above excerpt of paragraph 3, all elements of present Claim 1 were included in an embodiment of the investment management system (“IIMS”) in an actual reduction to practice of the claimed invention prior to February 24, 2000.

Actual reduction to practice of the claimed invention as described in the “Declaration to Antedate Cited Reference” is corroborated by a “Declaration of Clyde M. Kessinger” executed by Clyde M. Kessinger (see Attachment I – Exhibit A). Mr. Kessinger witnessed actual reduction to

practice of an embodiment of the invention with elements and features as claimed in Claim 1.

Attention is invited to paragraph 7 of the “Declaration of Clyde M. Kessinger”, which states:

Based on my experience with using the IIMS and to my knowledge prior to February 24, 2000, the IIMS provided the following features and functionality: (i) it was the first time I had seen a portfolio management system that offered ad-hoc reports that were account specific and leveraged the web so that wait time was de minimus; (ii) reports could be created quickly which allowed me to provide clients with quality presentations on short notice; (iii) before IIMS, I had to order reports which came on low quality paper and looked like they were hand typed, and they offered no analysis especially in regard to portfolio attribution; (iv) IIMS offered portfolio analysis from which we could gain a clear perspective on client accounts; (v) the IIMS was browser-based and provided users with the benefits of the web such as being able to go backward, seeing information in color, and using a point-and-click environment to obtain information more quickly; (vi) the IIMS included an application server in communication with a database server; (vii) the IIMS could perform analysis of investment portfolios by aggregating a plurality of securities in the investment portfolio by security type; (viii) the IIMS could monitor investment portfolios and generate reports associated with holdings of the investment portfolios; and (ix) the IIMS could perform operations using data from accounting systems and/or data vendors.

Actual reduction to practice of the claimed invention as described in the “Declaration to Antedate Cited Reference” is further corroborated by a “Declaration of William Scott Neff” executed by William Scott Neff (see Attachment I – Exhibit B). Mr. Neff witnessed actual reduction to practice of an embodiment of the invention with elements and features as claimed in Claim 1.

Attention is invited to paragraph 7 of the “Declaration of William Scott Neff”, which states:

Based on my experience with using the IIMS and to my knowledge prior to February 24, 2000, the IIMS provided the following features and functionality: (i) the IIMS received data from a trust accounting system, combined it with other vendor-provided data and provided portfolio analysis, monitoring and reporting functions; (ii) the IIMS performed portfolio rebalancing and trade upload, automating what was a manual task prior to the system

being rolled out; (iii) the IIMS included an application server in communication with a database server; (iv) the IIMS could perform analysis of investment portfolios by aggregating a plurality of securities in the investment portfolio by security type; (v) the IIMS could monitor investment portfolios and generate reports associated with holdings of the investment portfolios; and (vi) the IIMS could perform operations using data from accounting systems and/or data vendors.

In view of the foregoing Declarations contained in Attachment I, applicants respectfully request withdrawal of the rejections set forth in the Office Action based on Reddy as prior art under §102(e).

Each of Claims 2-6 and 24-29 ultimately depends from and further limits Claim 1, and each dependent claim is therefore allowable in view of Reddy for the same reasons discussed above with regard to Claim 1.

Independent Claim 7 is allowable for reasons analogous to those discussed above with regard to Claim 1. Each of Claims 8-21 and 30-32 ultimately depends from and further limits Claim 7, and each such dependent claim is therefore allowable for the same reasons as Claim 7.

Independent Claim 22 is allowable for reasons analogous to those discussed above with regard to Claim 1. Each of Claims 23, 33 and 34 depends from and further limits Claim 22, and each such dependent claim is therefore allowable for the same reasons as Claim 22.

Applicants respectfully request reconsideration and withdrawal of the rejections set forth under this section.

Evidence of Nonobviousness / Secondary Considerations

As objective evidence of secondary considerations such as unexpected results, commercial success, long-felt need, and failure of others, applicants submit herewith a “Declaration to Support Patentability of Claimed Invention” (see Attachment II) executed by Robert S. Stewart both as an inventor and as an officer of the assignee (InvestEdge, Inc.) of the present patent application. In various portions, the “Declaration to Support Patentability of Claimed Invention” provides evidence of commercial success (see, e.g., paras. 13-14); evidence of long-felt need (see, e.g., para. 15; see also para. 9 of “Declaration of William Scott Neff”); and, evidence of failure by others (see, e.g., para. 5).

Also, applicants have submitted the following evidence in the “Declaration to Support Patentability of Claimed Invention” with regard to the claimed invention: it does not involve merely combining prior art elements according to known methods to yield predictable results (see, e.g., para. 7); it does not involve use of known techniques to improve similar devices, methods or products in the same way (see, e.g., para. 8); it does not involve choosing from a finite number of identified, predictable solutions with a reasonable expectation of success and is not obvious to try (see, e.g., para. 9); it does not involve known work in one field of endeavor prompting predictable variations in the same or a different field based on design incentives or other market forces (see, e.g., para. 10); and, it does not arise from a teaching, suggestion, or motivation in the prior art that would have led one skilled in the art to modify or combine prior art references to arrive at the claimed invention (see, e.g., para. 11).

Favorable consideration of the pending claims is respectfully requested in view of submission of this objective evidence.

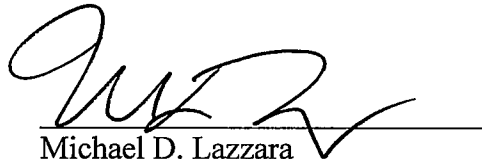
Miscellaneous

Applicants submit that the dependent claims pending herein are allowable at least by virtue of their dependency on independent claims which are patentable over the cited references. Applicants reserve the right, however, to make supplemental arguments as may be necessary, because the dependent claims of the present application include additional features that further distinguish the claims from the cited references. A detailed discussion of these distinctions is believed to be unnecessary at this time in view of the fundamental distinctions previously set forth.

SUMMARY

Applicants respectfully request allowance of all pending claims of the present application. The Examiner is invited to contact the undersigned representative by telephone or e-mail with any questions or outstanding issues associated with the application.

Respectfully submitted,



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